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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,584	05/16/2001	Thomas M. Collins	2280.2700	1405
26211	7590	03/29/2006	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			BATURAY, ALICIA	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/855,584

Applicant(s)

COLLINS ET AL.

Examiner

Alicia Baturay

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29,31,33,35,37 and 39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29,31,33,35,37 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09072001, 11152001, 03132006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), which was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 October 2005 has been entered.
2. Claims 1-12, 17, 18, 23, 24, 29, 31, 33, 35, 37 and 39 were amended.
3. Claims 30, 32, 34, 36 and 38 were cancelled.
4. Claims 1-29, 31, 33, 35, 37 and 39 are pending in this Office Action.

### ***Response to Amendment***

5. The objection to the specification regarding failing to provide proper antecedent basis for the term "machine-readable medium" has been withdrawn.
6. The rejection of claims 1-11 and 24 under 35 U.S.C. § 101 was addressed and is withdrawn.
7. Applicant's amendments and arguments with respect to claims 1-29, 31, 33, 35, 37 and 39 filed on 21 September 2005 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

*Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-4, 7-10, 12, 13-15, 18-21, 24-27, 31, 33, 35, 37 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Redpath (U.S. 6,256,672).

10. With respect to claim 1, Redpath teaches an article comprising a machine-readable medium storing machine-readable instructions that, when executed by the machine, cause the machine to perform the following operations:

Enable a sender to input a message (Redpath, Fig. 2B, element 138; col. 2, lines 56-59); enable the sender to append an attachment to the message (Redpath, Fig. 2B, element 140; col. 2, lines 62-64); enable the sender to designate at least one recipient of a plurality of recipients to receive the message and attachment (Redpath, Fig. 2B; col. 2, line 65 – col. 3, line 1); enable the sender to designate at least one recipient of the plurality of recipients to receive the message without the attachment (Redpath, Fig. 3, element 230; col. 3, lines 19-31); incorporate an icon in the message without the attachment, the icon indicative of the attachment to the at least one recipient to receive the message with the attachment (Redpath, col. 3, lines 48-51); and transmit the message over a network to the plurality of recipients wherein, the transmission to the at least one recipient of the plurality of recipients to receive

the message without the attachment uses less bandwidth of the network than the transmission to the at least one recipient of the plurality of recipients to receive the message with the attachment (Redpath, col. 3, lines 6-31).

11. With respect to claim 2, Redpath teaches the invention described in claim 1, including instructions that, when executed by the machine, cause the machine to send the message from a first computer to a second computer over the network (Redpath, Fig. 2A; col. 56-59).
12. With respect to claim 3, Redpath teaches the invention described in claim 2, including instructions that, when executed by the machine, cause the machine to send the message from the first computer to the second computer over an Internet network (Redpath, col. 1, lines 14-15).
13. With respect to claim 4, Redpath teaches the invention described in claim 2, including instructions that, when executed by the machine, cause the machine to send the message from the first computer to the second computer over a local area network (LAN) (Redpath, col. 2, lines 4-10).
14. With respect to claim 7, Redpath teaches an article comprising a machine-readable medium storing machine-readable instructions that, when executed by the machine, cause the machine to perform the following operations:

Allow a sender to designate a plurality of recipients of electronic mail (Redpath, Fig. 2B, elements 132 and 134; col. 2, line 65 – col. 3, line 1); transmit the electronic mail over a network to the plurality of recipients (Redpath, Fig. 2A; col. 56-59); associate each of the plurality of recipients with one of the following categories: a first category to indicate the recipient of the electronic mail is to receive both a text message and an attached file (Redpath, Fig. 3, element 220; col. 3, lines 6-31), a second category to indicate the recipient of the electronic mail is to receive both a text message and an attached file (Redpath, Fig. 3, element 222; col. 3, lines 6-31); a third category to indicate that the recipient of the electronic mail is to receive a text message without the attached file (Redpath, Fig. 3, element 230; col. 3, lines 6-31), incorporate an icon in the electronic mail of the third category, the icon indicative of the attachment for transmission to either the primary recipient or the secondary recipient (Redpath, col. 3, lines 48-51), where transmission to the tertiary recipient of the electronic mail uses less bandwidth of the network than the transmission to either the primary recipient or the secondary recipient (Redpath, col. 3, lines 6-31).

15. With respect to claim 31, Redpath teaches the invention described in claim 1, including instructions that, when executed by the machine, cause the machine to name the icon the same name as the attachment sent to the at least one recipient to receive the message with the attachment (Redpath, col. 3, lines 6-31).
16. Claims 8-10, 12, 13-15, 18-21, 24-27, 33, 35, 37 and 39 do not teach or define any new limitations above claims 1-4 and 31 and therefore are rejected for similar reasons.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 5, 6, 11, 16, 17, 22, 23, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Redpath and further in view of Thurlow et al. (U.S. 5,917,489).

Redpath teaches the invention substantially as claimed including one may provide an information copy of a note that preserves the style of the actual full note without including underlying attachment data. This allows an e-mail sender to notify addressees of what has been sent to the primary addressee without slowing down [sic] transmission time or wasting storage space by including unneeded and possibly quite large attachment files (see Abstract).

19. With respect to claim 5, Redpath teaches the invention described in claim 2, including instructions that, when applied to the machine, cause the machine to send the message from the first computer to the second computer over a network (Redpath, col. 1, lines 14-15).

Redpath does not explicitly teach the network being a WAN.

However, Thurlow teaches instructions that, when applied to the machine, cause the machine to send the message from the first computer to the second computer over a wide area network (WAN) (Thurlow, Fig. 1, element 52; col. 4, lines 45-56).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Redpath in view of Thurlow in order to enable the use of a WAN. One would be motivated to do so in order to enable the use of networking environments that are common in offices, enterprise-wide computer networks, intranets and the Internet.

20. Claims 11, 16, 22, and 28 do not teach or define any new limitations above claim 5 and therefore are rejected for similar reasons.
21. With respect to claim 6, Redpath teaches an article comprising a machine-readable medium storing machine-readable instructions that, when executed by the machine, cause the machine to perform the following operations:
- Enable a sender to input a message (Redpath, Fig. 2B, element 138; col. 2, lines 56-59); enable the sender to append an attachment to the message (Redpath, Fig. 2B, element 140; col. 2, lines 62-64); enable the sender to designate at least one recipient of a plurality of recipients to receive the message and the attachment (Redpath, Fig. 2B; col. 2, line 65 – col. 3, line 1); enable the sender to designate at least one recipient of the plurality of recipients to receive the message without the attachment (Redpath, Fig. 3, element 230; col. 3, lines 19-31); and transmit the message over a network to the plurality of recipients wherein, the transmission to the at least one recipient of the plurality of recipients to receive the message without the attachment uses less bandwidth of the network than the transmission to the at least one recipient of the plurality of recipients to receive the message with the attachment (Redpath, col. 3, lines 6-31).



Art Unit: 2155

Redpath does not teach the use of a user profile.

However, Thurlow teaches enabling each recipient to create and edit a recipient profile, the profile including the recipient's preferences with regard to receipt of prospective attachments (Thurlow, col. 10, lines 55-67; col. 11, Table 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Redpath in view of Thurlow in order to enable the use of a user profile.

One would be motivated to do so in order to allow for an improved method of creating and editing rules for processing electronic mail.

22. Claims 17, 23 and 29 do not teach or define any new limitations above claim 6 and therefore are rejected for similar reasons.

***Response to Arguments***

23. Applicant's arguments filed 22 December 2005 have been fully considered, but they are not persuasive for the reasons set forth below.

24. ***Applicant Argues:*** Applicant states "Therefore, the Kohler patent does not disclose or suggest that a recipient who receives the message without the attachment will, nevertheless, receive the icon in the message as recited in claim 1."

***In Response:*** The examiner respectfully submits that Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

25. ***Applicant Argues:*** Applicant states "Therefore, neither the Thurlow et al. patent nor the other cited references discloses or suggests a profile that includes the recipient's preferences in regard to 'receipt of prospective attachments.'"

***In Response:*** The examiner respectfully submits that in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., whether or not a particular attachment should be sent for by receipt by the recipient) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.

1993). The American Heritage College Dictionary defines “receipt” as “the act of receiving.” Therefore the aforementioned limitation of claim 6 stated as “receipt of prospective attachments” is interpreted as “receiving of prospective attachments.” The examiner respectfully submits that Thurlow teaches a user working through the process of selecting available conditions (recipient’s preferences) including if the message has an attachment (see Thurlow, col. 11, Table I, last line). The conditions include a field to indicate when the rule will be applied, which can be when the messages are received (receipt of prospective attachments) or on existing folders where messages are already present (receipt of current attachments – see Thurlow, col. 11, lines 19-45). This renders the rejection proper, and the rejection stands.

Art Unit: 2155

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay  
March 20, 2006

  
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SUPERVISORY PATENT EXAMINER